



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/473,360 | 12/28/1999 | SOON-JIN KIM | 678-427-(P89 | 9893 |

7590 07/27/2004

PAUL J FARRELL ESQ
DILWORTH AND BARRESE
333 EARLE OVINGTON BOULEVARD
UNIONDALE, NY 11553

| EXAMINER |
|----------|
|----------|

NGUYEN, TU X

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2684

23

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,360

Applicant(s)

KIM, SOON-JIN

Examiner

Tu X Nguyen

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/6/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicant's arguments filed 5/6/04 have been fully considered but they are not persuasive.

Applicant argue that Jonsson et al. utilizing the digital symbols are converted into a formant frequency which is supplied to a voice coder so as to be output by means of the voice coder. Therefore, according to claim amendment, "transmitting the written character message including non-converted character data", and therefore, a conversion into a formant frequency is unnecessary. Jonsson et al. teach several exemplary apparatus for communicating input symbols over a speech channel. One of embodiment Jonsson et al. teach that the symbols are converted into a formant frequency and output to a voice coder. However, another embodiment Jonsson et al. teach "In still another exemplary application, the user may send short messages or commands to the server both during voice conversation and when no communication is going on" (see col.10 lines 39-44). Those skilled in the art would acknowledge that a short (text) message which is not in any form of conversion format and no need to pass through a voice coder before transmission.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2684

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Jonsson et al. (US Patent 6,385,585).

As to claim 1, Jonsson et al. disclose a method for transmitting a character message in a mobile communication terminal while maintaining a conversation by telephone (see col.10 lines 32-39), the examiner interprets "during an ongoing conversation" reads on "while maintaining conversation", comprising the steps of:

Setting the mobile communication terminal to a character message-transmitting/receiving mode while in a state in which a speech path has been established between the mobile communication terminal and a mobile communication terminal of a party other than the user (see col.3 lines 46-67); and

inputting a character message while in the character message-transmitting/receive mode, processing the written character message and transmitting the written character message including non-converted character data to the communication terminal of the other party via the established speech path in the character message-transmitting/receiving mode (see col.10 lines 39-44).

As to claim 2, Jonsson et al. disclose returning the mobile communication terminal of the user to a phone mode after the transmission of the character message to the mobile communication terminal of the other party (see col.11 lines 39-44).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson et al. and further in view of Makela et al. (US Patent 6,301,338).

As to claim 3, Jonsson et al. fail to disclose the character message input during the character message-transmitting/receiving mode is selected among character messages previously written and stored in a registered state.

Makela et al. disclose the character message input during the character message-transmitting/receiving mode is selected among character messages previously written and stored in a registered state (see col.5 lines 44-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Jonsson et al. with the above teaching of Makela et al. in order to provide user conveniently to transmit pre-stored messages to other party.

7. Claims 4-5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson et al. and further in view of Svensson (US Patent 5,687,216).

As to claim 4, Jonsson et al. fail to disclose receiving a character message from the mobile communication terminal of the other party, the mobile communication terminal displaying the received character message.

Art Unit: 2684

Svensson discloses receiving a character message from the mobile communication terminal of the other party, the mobile communication terminal displaying the received character message (see col.6 lines 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Jonsson et al. with the above teaching of Svensson in order to provide another message is received before the users reads the current message (as suggested by Svensson, see col.6 lines 1-7).

As to claim 5, the modified Jonsson et al. disclose all limitations as to claims 1 and 4 above.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond S Dean whose telephone number is 703-305-8998. The examiner, Tu Nguyen 703-305-3427, can normally be reached on 8:00-4:30AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MAUNG NAY A, can be reached at (703) 308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

TW
July 14, 2004

NAY MAUNG
SUPERVISORY PATENT EXAMINER